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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/612,766	07/10/2000	James L. Hepworth	23802-250800	8887

7590 08/13/2002  
Pillsbury Madison & Sutro LLP  
725 South Figueroa Street Suite 1200  
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EXAMINER

LY, ANH

ART UNIT	PAPER NUMBER
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2172

DATE MAILED: 08/13/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/612,766

Applicant(s)

HEPWORTH ET AL.

Examiner

Anh Ly

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 24 May 2002.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-16 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-16 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.  
 If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
 a) ☐ All b) ☐ Some \* c) ☐ None of:  
 1. ☐ Certified copies of the priority documents have been received.  
 2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
 \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).  
 a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)                      4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)                      5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_                      6) ☐ Other: \_\_\_\_\_

**DETAILED ACTION**

***Response to Arguments***

1. Applicant's arguments filed on 05/24/2002 with respect to claims 1-16 have been considered but are moot in view of the new ground(s) of rejection.
2. Claims 1-16 are pending in this application.

***Claim Rejections - 35 USC § 103***

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of

the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

5. Claims 1-2, 6-7 and 12-13 are rejected under 35 U.S.C. 103(a) as being unpatentable over US Patent No. 6,148,289 issued to Viridy in view of US Patent No. 6,175,830 issued to Maynard.

With respect to claim 1, Viridy discloses entering the at least one trademark, trade-name, celebrity name and famous name to be search as claimed (col. 3, lines 16-25 and lines 42-51, see item 122 in fig. 1, col. 4, lines 54-67, col. 6, lines 1-12 and col. 8, lines 50-55); entering a URL address of a web page on the Internet to be searched as claimed (col. 2, lines 26-39 and col. 3, lines 42-51); accessing and searching the contents of web page for the URL address entered for matches and the web page of the URL address entered (col. 4, lines 20-25, col. 5, lines 9-16 and lines 32-47 and col. 6, lines 1-12).

Viridy does not explicitly indicate, "creating a search string and matches the corresponding to the search string."

However, Maynard discloses search string to be supplied and searching the web page on the internet or database (abstract, fig. 2B, fig. 3 and fig. 5B, col. 1, lines 40-67, col. 4, lines 6-32, col. 6, lines 58-67 and col. 7, lines 1-47).

Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to combine the teachings of Viridy with the teachings of Maynard so as to obtain a method of searching and reporting an incidence of at least one a trademark, trade-name, celebrity name and famous name on an Internet because the combination would provide the data is kept in the InterNic database for the records of registered domain names containing company name, contact, address and IP address are kept on the multiple search engines of the Internet network environment.

With respect to claim 2, Viridy discloses the hyperlinks as claimed (col. 3, lines 26-42, and col. 6, lines 1-12).

Claim 6 is essentially the same as claim 1 except that it is directed to a system for searching and reporting an incidence rather than a method ('289 of col. 3, lines 16-25 and lines 42-51, see item 122 in fig. 1, col. 4, lines 54-67, col. 6, lines 1-12 and col. 8, lines 50-55; col. 2, lines 26-39 and col. 3, lines 42-51; col. 4, lines 20-25, col. 5, lines 9-16 and lines 32-47 and col. 6, lines 1-12; '830 of abstract, fig. 2B, fig. 3 and fig. 5B, col. 1, lines 40-67, col. 4, lines 6-32, col. 6, lines 58-67 and col. 7, lines 1-47), and is rejected for the same reason as applied to the claim 1 hereinabove.

Claim 7 is essentially the same as claim 2 except that it is directed to a system for searching and reporting an incidence rather than a method (col. 3, lines 26-42, and col. 6, lines 1-12), and is rejected for the same reason as applied to the claim 2 hereinabove.

Claim 12 is essentially the same as claim 1 except that it is directed to a software program executing on a computer system for searching and reporting an incidence

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rather than a method ('289 of col. 3, lines 16-25 and lines 42-51, see item 122 in fig. 1, col. 4, lines 54-67, col. 6, lines 1-12 and col. 8, lines 50-55; col. 2, lines 26-39 and col. 3, lines 42-51; col. 4, lines 20-25, col. 5, lines 9-16 and lines 32-47 and col. 6, lines 1-12; '830 of abstract, fig. 2B, fig. 3 and fig. 5B, col. 1, lines 40-67, col. 4, lines 6-32, col. 6, lines 58-67 and col. 7, lines 1-47), and is rejected for the same reason as applied to the claim 1 hereinabove.

Claim 13 is essentially the same as claim 2 except that it is directed to a software program executing on a computer system for searching and reporting an incidence rather than a method (col. 3, lines 26-42, and col. 6, lines 1-12), and is rejected for the same reason as applied to the claim 2 hereinabove.

6. Claims 3, 8, 11 and 14 are rejected under 35 U.S.C. 103(a) as being unpatentable over US Patent No. 6,148,289 issued to Viridy in view of US Patent No. 6,175,830 issued to Maynard and further in view of US Patent No. 6,141,653 issued to Conklin et al. (hereinafter as Conklin).

With respect to claim 3, Viridy in view of Maynard discloses a method for searching and reporting an incidence as discussed in claim 1.

Viridy in view of Maynard does not explicitly indicate, "an encrypted connection authenticated by a certificate server."

However, Conklin discloses data is kept secure and communications over the Internet by SSL (secure sockets layer) (col. 22, lines 8-29).

Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to combine the teachings of Viridy in view of Maynard with the teachings of Conklin so as to have an encrypted connection by a certificate server (SSL) because the combination would provide the data is kept in the InterNic database having a secure location inside an Internet Protocol (IP) firewall at the commerce provider site (Conklin – col. 14, lines 45-55) in the searching information over the Internet network environment.

Claim 8 is essentially the same as claim 3 except that it is directed to a system for searching and reporting an incidence rather than a method (col. 22, lines 8-29), and is rejected for the same reason as applied to the claim 3 hereinabove.

With respect to claim 11, Viridy in view of Maynard discloses a system for searching and reporting an incidence as discussed in claim 6.

Viridy in view of Maynard does not explicitly indicate “a remote computer system connected to the computer system via the Internet for accessing the software program.”

However, Conklin discloses the remote Web including Web server software (as item 210s in fig. 1d) (col. 21, lines 20-45 and col. 23, lines 10-40).

Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to combine the teachings of Viridy in view of Maynard with the teachings of Conklin so as to have an encrypted connection by a certificate server (SSL) because the combination would provide the data is kept in the InterNic database having a secure location inside an Internet Protocol (IP) firewall at the

commerce provider site (Conklin – col. 14, lines 45-55) in the searching information over the Internet network environment.

Claim 14 is essentially the same as claim 3 except that it is directed to a software program executing on a computer system for searching and reporting an incidence rather than a method (col. 22, lines 8-29), and is rejected for the same reason as applied to the claim 3 hereinabove.

7. Claims 4-5, 9-10 and 15-16 are rejected under 35 U.S.C. 103(a) as being unpatentable over US Patent No. 6,148,289 issued to Viridy in view of US Patent No. 6,175,830 issued to Maynard and further in view of US Patent No. 6,144,962 issued to Weinberg et al. (hereinafter as Weinberg).

With respect to claim 4, Viridy in view of Maynard discloses a method for searching and reporting as discussed in claim 1.

Viridy in view of Maynard does not explicitly indicate, “the search results highlight the trademark, trade name, celebrity name, and famous name found in the web page.”

However, Weinberg discloses the highlight the text as claimed (col. 2, lines 20-26, col. 7, lines 60-67, col. 8, lines 1-8 and col. 17, lines 5-20).

Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to combine the teachings of Viridy in view of Maynard with the teachings of Weinberg so as to have the highlight the text because the combination would provide the InterNIC database for the records of registered domain



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names containing company name, contact, address and IP address are kept on the multiple search engines of the Internet network environment.

With respect to claim 5, Viridy in view of Maynard discloses a process for searching and reporting as discussed in claim 1.

Viridy in view of Maynard does not explicitly indicate "the homonyms and phonetic equivalent."

However, Weinberg discloses the spell checker as claimed (col. 20, lines 3-8).

Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to combine the teachings of Viridy in view of Maynard with the teachings of Weinberg so as to have the step for searching the hidden text, text, titles and domain names because the combination would provide the InterNIC database for the records of registered domain names containing company name, contact, address and IP address are kept on the multiple search engines of the Internet network environment.

Claim 9 is essentially the same as claim 4 except that it is directed to a system for searching and reporting an incidence rather than a method (col. 2, lines 20-26, col. 7, lines 60-67, col. 8, lines 1-8 and col. 17, lines 5-20), and is rejected for the same reason as applied to the claim 4 hereinabove.

Claim 10 is essentially the same as claim 5 except that it is directed to a system for searching and reporting an incidence rather than a method (col. 0, lines 3-8), and is rejected for the same reason as applied to the claim 5 hereinabove.

Claim 15 is essentially the same as claim 4 except that it is directed to a software program executing on a computer system for searching and reporting an incidence rather than a method (col. 2, lines 20-26, col. 7, lines 60-67, col. 8, lines 1-8 and col. 17, lines 5-20), and is rejected for the same reason as applied to the claim 4 hereinabove.

Claim 16 is essentially the same as claim 5 except that it is directed to a software program executing on a computer system for searching and reporting an incidence rather than a method (col. 0, lines 3-8), and is rejected for the same reason as applied to the claim 5 hereinabove.

### ***Conclusion***

8. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not

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mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

### **Contact Information**

9. Any inquiry concerning this communication should be directed to Anh Ly whose telephone number is (703) 306-4527. The examiner can be reached on Monday - Friday from 8:00 AM to 4:00 PM.

If attempts to reach the examiner are unsuccessful, see the examiner's supervisor, Kim Vu, can be reached on (703) 305-4393.

Any response to this action should be mailed to:

Commissioner of Patents and Trademarks

Washington, D.C. 20231

or faxed to:

(703) 746-7238 (after Final Communication)

or:

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(703) 746-7239 (for formal communications intended for entry)

or:

(703) 746-7240 (for informal or draft communications, please

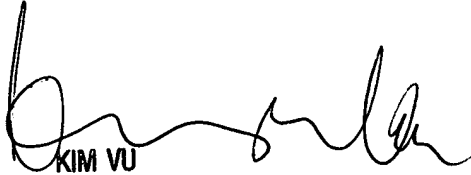
label "PROPOSED" or "DRAFT")

Hand-delivered responses should be brought to Crystal Park II, 2121 Crystal Drive, Arlington, VA, Fourth Floor (receptionist).

Inquiries of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 305-3900.

AL A

Jul. 31<sup>st</sup>, 2002.

  
KIM VU  
SUPERVISORY PATENT EXAMINER  
TECHNOLOGY CENTER 2100